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PRE-APPEAL BRIEF REQUEST FOR REVIEW

		Docket Number (Optional): DKT00126
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on October 31, 2005 Signature: [signature] Typed or printed name: Jon A. Birmingham	Application Number: 09/879,580 First Named Inventor: Naosumi Tada Art Unit: 3682	Filed: June 12, 2001 Examiner: Charles, Marcus

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record. Registration number 51,222

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34.

[signature]
Signature
Jon A. Birmingham
Typed or printed name
312-577-7000
Telephone number
10/31/05
Date

Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.	09/879,580
Filed:	June 12, 2001
Applicant(s):	Tada
Title:	Blade Tensioner
Art Unit:	3682
Examiner:	Charles, Marcus

Attorney Docket No.: DKT00126

Confirmation No. 4790

CERTIFICATE OF MAILING

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10/31/05
Date

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir or Madam:

This Pre-Appeal Brief Request for Review is filed pursuant to the Pre-Appeal Brief Conference Pilot Program and the "Notice of Appeal from the Primary Examiner to the Board of Patent Appeals and Interferences" under 37 C.F.R. § 41.37. Appellant respectfully submits that the final rejection of the pending claims is based on clear errors of law. Applicant expressly reserves, and does not waive, all additional issues for appeal that are not discussed herein, including without limitation, errors of fact made in the rejection, which Applicant understands will not be considered in a Pre-Appeal Conference.

STATUS OF CLAIMS:

Appellant appeals the final rejection of the pending claims 1, 5–6, and 13–14. Claims 1 and 13 are the pending independent claims at issue in this appeal. Claims 1, 5–6, and 13–14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,425,680 to Young in view of U.S. Patent Nos. 5,984,815 to Baddaria and 5,184,982 to Shimaya et al.

SUMMARY OF ARGUMENTS:

The applicant respectfully asserts that the rejection of claims 1, 5–6, and 13–14 under 35 U.S.C. § 103(a) set forth in the Office action dated June 30, 2005 is based on clear of law and, thus, should be rescinded.

1. Appellant's invention is generally directed to blade tensioners utilizing a friction surface to improve dampening. The blade tensioner is configured with a blade shoe having a chain sliding face on one side and, on an opposing side, a plurality of blade springs. One portion of the shoe is pivotably supported, and a second portion is slidable relative to a base sliding face.

When the blade springs apply spring force to the shoe to urge the chain sliding face of the shoe against a chain, the second portion of the shoe may slide relative to the base sliding face. In order to improve the dampening characteristics of the blade tensioner, a friction surface is disposed between the second blade shoe portion and the sliding face of the base. The coefficient of friction between the friction surface and the second blade shoe is different than a coefficient of friction between the sliding face of the base and the second blade shoe portion effective to damp vibrations of the tensioner when the second blade shoe portion sides on the friction surface. The aspects of the invention subject to this appeal are described in the pending claims.

2. It is undisputed that none of the cited references disclose a friction surface between a second blade shoe portion and the sliding face of the base of a chain tensioner, as discussed in greater detail in the Amendment dated March 22, 2005, at pages 7-8. For example, neither Badarria, Young nor Shimaya disclose, as set forth in independent claims 1 and 13, a "friction surface disposed between the second blade shoe portion and the sliding face of the base, a coefficient of friction between the friction surface and the second blade shoe portion being different than a coefficient of friction between the sliding face of the base and the second blade shoe portion effective to damp vibrations of the tensioner when the second blade shoe portion slides on the friction surface." Moreover, additional limitations found in claims 1, 5–6, and 13–14 are not met by the Shimaya reference. The claim limitations not disclosed by the Shimaya reference are detailed in the Amendment dated March 22, 2005.

3. The rejection cannot be sustained as matter of law as it fails to provide evidence of the suggestion and motivation for one of ordinary skill to make the cited combination of references, without the use of hindsight based on Appellant's disclosure. "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." *Ecolochem, Inc. v. S. Cal. Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 974 (2001), (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998). "The lack of evidence of a motivation to combine is a critical defect" to an obviousness argument. *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1336 (Fed. Cir. 2004).

There is no dispute that Shimaya is directed to a plunger-activated tensioner, as opposed to the claimed blade tensioner, and the blade-activated tensioners of Young and Badderia (*see also* Amendment dated March 22, 2005, at page 8). Shimaya further discloses and requires ***nonsliding*** contact between the planar face

48 of the plunger 44 and the convex face 50 of the pad 49 attached to the shoe 59. Shimaya, e.g., col. 2, ll. 13-46, teaches that sliding contact between the plunger and convex face in response to vibration forces is undesirable and detrimental to its system. Thus, Shimaya requires a specially-shaped convex pad face configured to exert forces on a line of contact between the pad and the plunger face. The result, according to Shimaya, is that ***"transverse forces [i.e., sliding forces] on the plunger are substantially eliminated."*** Col. 4, ll. 40-51.

Instead, Shimaya discloses a smooth, rocking engagement between the pad and the plunger face, which is bears no relation to the sliding, frictional engagement between blades and shoe required by the pending claims. Indeed, Shimaya's plunger system uses different components, different component configurations, and operates on entirely different principles than the claimed system, as well as the blade systems of Young and Badderia.

Accordingly, Shimaya cannot provide the motivation required as a matter of law for the rejection's proposed combination of references, and the rejection does not identify any basis for finding such motivation in Young, Badderia or any other source. Indeed, there is no suggestion in the cited references that any of the systems of Shimaya, Young or Badderia utilize, or could utilize, the blade, shoe and friction surfaces of Appellant's claims to damp vibrations in a blade tensioner. The lack of evidence of the required motivation for the combination of the references also is discussed in the Amendment dated March 22, 2005, at page 8.

4. The rejection also errs as a matter of law in failing to address Shimaya's teaching away from the combination of Shimaya, Young and Badderia asserted in the rejection. "[A]n applicant may rebut a prima facie case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect." *In re Peterson*, 315 F.3d 1325, 1331 (Fed. Cir. 2003). For the reasons discussed above in paragraph 3, Shimaya's teaching that sliding contact

between its components should be avoided and is undesirable directs those of ordinary skill away from the Appellant's claimed system. Indeed, Shimaya teaches that frictional, sliding contact between components is the ***problem*** that Shimaya's system is intended to remedy, rather than a useful aspect of the system that can be increased to provide vibration damping.

Applicant respectfully submits that these errors of law are sufficient, without consideration of other errors of fact and law, to require reconsideration and reversal of the rejection of the pending claims.

Respectfully submitted,
FITCH, EVEN, TABIN & FLANNERY

Date: October 31, 2005

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